THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JEFFREY L. BRINEN

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Appeal No. 97-2098
Application 08/401,514[1]

_____

ON BRIEF

_____

Before GARRIS, WARREN, and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

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[1] Application for patent filed March 10, 1995. According to appellant, this application is a continuation-in-part of Application No. 08/174,498, filed December 28, 1993, now abandoned.

This is a decision on an appeal from the final rejection of claims 1 through 10 and 12 through 16 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method for prepolymerization of a supported catalyst system which comprises prepolymerizing a highly active supported metallocene catalyst system with olefin monomer feed in the presence of hydrogen. Further details of this appealed subject matter are set forth in representative independent claim 1, the sole independent claim before us, which reads as follows:

1. A method for prepolymerization of a supported catalyst system comprising:

(a) combining:

(i) a supported metallocene catalyst system having an activity greater than about 100,000 g/g/hr.;

(ii) at least one alpha olefin monomer feed; and

(iii) added hydrogen under prepolymerization reaction conditions; and

(b) recovering a prepolymerized supported catalyst system.

The reference relied upon by the examiner as evidence of obviousness is:

Tsutsui et al. 5,266,544 Nov. 30, 1993
(Tsutsui)

All of the appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Tsutsui.[2]

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejection.

OPINION

For the reasons set forth in the answer and below, we will sustain the rejection before us.

We agree with the examiner that the Tsutsui reference evinces a prima facie case of obviousness with respect to a method for prepolymerizing the catalyst systems disclosed therein, including those having an activity within the here claim range, with an olefin monomer feed and added hydrogen. In support of his contrary view, the appellant argues that "(1) Tsutsui discloses a vast number of metallocenes with no

[2] As correctly indicated on page 2 of the answer, the claims on appeal will stand or fall together; see 37 CFR § 1.192(c)(7) (1995).

direction toward selecting those having high activity, specifically greater than about 100,000 g/g/hr, for prepolymerization with hydrogen; and (2) Tsutsui leads away from selecting the metallocenes required by Applicant's claims [because] [i]n the examples,
Tsutsui uses only one type of metallocene, namely, bis(methylcyclopentadienyl) zirconium dichloride" (brief, page 4). This argument is unpersuasive.

In the first place, we share the examiner's view that Tsutsui discloses in columns 7 and 8 a relatively limited list of transition metal compounds which are zirconium-based as preferred by patentee (e.g., see lines 59 through 62 in column 6) and which include those disclosed by the appellant (according to the examiner's undisputed finding in the paragraph bridging pages 5 and 6 of the answer). Furthermore, we perceive no logic in the appellant's viewpoint that Tsutsui's exemplification of only one metallocene type somehow leads away from the other metallocenes disclosed by patentee including those having a high activity. We see no reason why an artisan with ordinary skill would have attached any

significance to the fact that Tsutsui's examples utilize only one type of metallocene.

Having determined that a prima facie case of obviousness has been established, we must now begin anew our assessment of the obviousness issue before us taking into account all evidence of record for and against an obviousness conclusion. See, for example, In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

As evidence of nonobviousness, the appellant points to the examples in his specification which are said to evince that the here claimed method yields the unexpected result of inhibited reactor fouling and catalyst agglomeration. However, even if such results are assumed to be unexpected, the specification examples referred to by the appellant plainly are evidentially inadequate to outweigh the reference evidence adduced by the examiner. This is because the examples under consideration (i.e., Examples 5 through 8) involve only a single catalyst system having an activity of 360,000 g/g/hr. In contrast, the independent claim on appeal is significantly broader in reciting "a supported metallocene catalyst system having an activity greater than about 100,000

g/g/hr." Unquestionably, the appellant's evidence of nonobviousness is considerably more narrow in scope than the argued claim on appeal.

It is well settled that evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims to which it pertains and that evidence which is considerably more narrow in scope than the claimed subject matter is not sufficient to rebut a prima facie case of obviousness. In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). Thus, even assuming that the specification examples evince unexpected results as urged by the appellant, it is clear that such evidence, being considerably more narrow than the argued claim on appeal, is not sufficient to rebut or outweigh the examiner's reference evidence of prima facie obviousness. It follows that we will sustain the examiner's section 103 rejection of claims 1 through 10 and 12 through 16 as being unpatentable over Tsutsui.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

Appeal No. 97-2098
Application No. 08/401,514

AFFIRMED

Bradley R. Garris Administrative Patent Judge	)	
Charles F. Warren Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Peter F. Kratz Administrative Patent Judge	)	

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